

Examiner for the withdrawal of the Section 112 rejections. The only issues remaining are those under Section 102(b). An Appendix with the pending claims is attached for the Examiner's convenience.

REJECTION UNDER 35 U.S.C. §102(b)

Claims 1-2 and 4-7 are rejected under 35 U.S.C. §102(b) as being anticipated by Saito et al. (Saito). Applicants respectfully traverse.

Saito (GenBank Accession No. U29174) is not prior art under 102(b)

The Examiner states that Saito (GenBank Accession No. U29174) discloses the claimed sequence more than one year before the priority date of July 25, 1996. In making the rejection, the Examiner relies on the date June 14, 1995, the date that the sequence was submitted to GenBank.

Applicants enclose a declaration indicating that Accession No. U29174 was released from GenBank to the public on January 2, 1996. Since January 2, 1996 is within one year of Applicants' priority date, Saito is not prior art under 102(b). Therefore, Applicants respectfully request withdrawal of the rejection.

Saito (Molec. Cell. Neurosci.) is not prior art under 102(b) or 102(a)

The Examiner states that the reference Saito et al. (Molec. Cell. Neurosci.), referenced in the GenBank submission, was published June 1, 1995 and thereby constitutes a statutory bar against Applicant's invention.

Applicants enclose a declaration stating that the journal containing the referenced article was mailed from the printer August 22, 1995. Thus, Saito et al. (Molec. Cell. Neurosci.) was not available to public more than one year before the priority date of July

25, 1996, and is not prior art under 102(b).


The Examiner states that even if Saito et al. (Molec. Cell. Neurosci.) is not prior art under 102(b), the reference is prior art under 102(a) as the four authors are not the same inventive entity of the instant application.

Applicants enclose a declaration under 37 C.F.R. §1.132, in accordance with *In re Katz*, which states that authors Amy Greenwood and Qi Sun are not inventors of the above-identified application. Thus, Saito et al. (Molec. Cell. Neurosci.) is not prior art under 102(a). Applicants therefore request that the rejection be withdrawn.

For all the foregoing reasons, Applicants respectfully submit that the claims are in condition for allowance and such allowance is earnestly solicited. If any issues which preclude allowance remain, please call the under-signed at (415) 781-1989 to resolve such issues.

Respectfully Submitted,

**FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP**


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Four Embarcadero Center, Suite 3400
San Francisco, CA 94111-4187

Dated: December 22, 1998

APPENDIX--

1. (Amended) An isolated nucleic acid encoding a DRG11 protein, wherein said nucleic acid hybridizes under high stringency conditions to a complement of a nucleic acid molecule having a sequence as set forth in SEQ ID NO:1, and wherein said DRG11 protein is characterized by its natural expression in sensory neurons and dorsal horn neurons of the spinal cord and wherein its natural expression is absent in non-neuronal cells, sympathetic neurons and ventricular neurons of the spinal cord.

2. (Twice Amended) An isolated nucleic acid according to claim 1 encoding the amino acid sequence depicted in Figure 3 (SEQ ID NO:2).

4. (Twice Amended) An isolated nucleic acid according to claim 1 comprising the nucleic acid depicted in Figure 2 (SEQ ID NO:1).

5. (Amended) An isolated nucleic acid according to claim 1 operably linked to an expression vector comprising transcriptional and translational regulatory DNA.

6. A host cell transformed with an expression vector according to claim 5.

7. (Amended) A method of producing a DRG11 protein comprising:
a) culturing a host cell transformed with an expression vector comprising a nucleic acid according to claim 1; and
b) expressing said nucleic acid to produce a DRG11 protein.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: R. Hayes
)	
ANDERSON et al.)	Group Art Unit: 1645
)	
Serial No. 08/701,278)	San Francisco, California
)	
Filed: August 22, 1996)	
)	
For: A NOVEL HOMEODOMAIN)	
PROTEIN)	
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DECLARATION OF ROBERT L. McCARTHY

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

I, Robert L. McCarthy, hereby declare and state as follows:

1. I am an employee of the law firm of Flehr, Hohbach, Test, Albritton & Herbert located in San Francisco, California.

2. At the request of Dolly A. Vance, an associate in the Flehr firm, I contacted Meredith Sherry, a senior developmental editor with Academic Press, to determine when Volume 6 of *Molecular and Cellular Neuroscience* was published. I was informed that the edition which contained the publication Saito *et al*, "Identification by Differential RT-PCR of a Novel Paired Homeodomain Protein Specifically Expressed in Sensory Neurons and a Subset of Their CNS Targets," *Molecular and Cellular Neuroscience*, Vol. 6, pp 280-292, was mailed from the printer on August 22, 1995.

3. I hereby declare that all statements made herein of my own knowledge are

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true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Date Dec. 22, 1948 By Robert L. McCarthy
Robert L. McCarthy



PATENT

Attorney Docket No. A-63770-1/RFT/DAV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ANDERSON et al.

Serial No. 08/701,278

Filed: August 22, 1996

For: A NOVEL HOMEODOMAIN
PROTEIN

) Examiner: R. Hayes
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Group Art Unit: 1645

DECLARATION UNDER 37 C.F.R. § 1.132

The Assistant Commissioner for Patents
Washington D.C. 20231

Sir:

The undersigned, David J. Anderson, hereby declares as follows:

1. I am a co-inventor with Tetsuichiro Saito of the invention claimed in the above-identified application.

2. I am a co-author of "Identification by Differential RT-PCR of a Novel Paired Homeodomain Protein Specifically Expressed in Sensory Neurons and a Subset of Their CNS Targets", Saito, et al., *Molecular and Cellular Neuroscience*, (6) 280-292, (1995) (MCN publication), wherein my co-authors are Tetsuichiro Saito, Amy Greenwood, and Qi Sun.

3. The work in the MCN publication that was contributed by Amy Greenwood and Qi Sun did not rise to the level of inventorship in the above-identified

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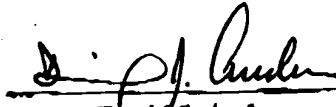
application.

4. Amy Greenwood at the time of her contribution to the *MCN* publication was working under my or Tetsuichiro Saito's supervision. She did not collaborate in the conception of the invention.

5. The position of Qi Sun at the time of contribution to the *MCN* publication was working under my or Tetsuichiro Saito's supervision. Qi Sun did not collaborate in the conception of the invention.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Date: 12/21/98


David J. Anderson



PATENT

Attorney Docket No. A-63770-1/RFT/DAV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: R. Hayes
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ANDERSON et al.)	Group Art Unit: 1645
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Serial No. 08/701,278)	San Francisco, California
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Filed: August 22, 1996)	
)	
For: A NOVEL HOMEODOMAIN)	
PROTEIN)	
_____)	

DECLARATION OF AMY F. ZIOBER

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

I, Amy F. Ziober, hereby declare and state as follows:

1. I am an employee of the law firm of Flehr, Hohbach, Test, Albritton & Herbert located in San Francisco, California.

2. At the request of Dolly A. Vance, an associate in the Flehr firm, I contacted Susan Kimball with GenBank User Services at the National Library of Medicine to determine when GenBank Accession No. U29174 was first released to the public. I was informed that the first date of public release for U29174 was January 2, 1996.

3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements

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and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C.
1001 and that such willful, false statements may jeopardize the validity/enforceability of
the application or any patent issued thereon.

Date 11/10/98

By Amy Ziober
Amy F. Ziober